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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,733	07/22/2003	William E. Fristad	00155-00388-US	6069
45847	7590	05/02/2006		EXAMINER
CONNOLLY BOVE LODGE & HUTZ LLP PO BOX 2207 WILMINGTON, DE 19899-2207				GREEN, ANTHONY J
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/623,733	FRISTAD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony J. Green	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 June 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 18-25 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 and 26-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/16/04&1/06/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group I, claims 1-17 and 26-40 in the reply filed on 21 June 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1, 10-17, 26 and 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolan (US Patent No. 5,427,632).

Dolan teaches, in the abstract, examples and the claims, a chromium free conversion coating composition comprising a component of anions such as fluorotitanate or fluozirconate, a component of cations of elements, sufficient free acid so that the pH is in the range of from 0.5 to 5.0, a component of phosphorus containing inorganic oxyanions and phosphonate anions, and a component of polymers.

The instant claims are met by the reference. It is the position of the examiner that the component of cations of elements meets applicants acid-stable particles absent evidence to the contrary. As for the property of the particles maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise.

4. Claims 1, 10-17, 26 and 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolan et al (US Patent No. 5,356,490).

Dolan teaches, in the abstract, examples and the claims, an aqueous mixture of a fluoroacid and an oxide, hydroxide or carbonate of silica, aluminum or zirconium. The component may be mixed with polymers or chromium. According to column 4, lines 62+, the pH is in the range of from 0 to 4.

The instant claims are met by the reference. It is the position of the examiner that the oxide, hydroxide or carbonate of silica, aluminum or zirconium meets applicants acid-stable particles absent evidence to the contrary. As for the property of the particles

maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise.

5. Claims 1, 10-17, 26 and 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolan et al (US Patent No. 5,281,282).

Dolan teaches, in the abstract, examples and the claims, an aqueous mixture of a fluoroacid and an oxide, hydroxide or carbonate of silica, aluminum or zirconium. The component may be mixed with polymers or chromium. According to column 4, lines 16-22, the pH is in the range of from 0 to 4.

The instant claims are met by the reference. It is the position of the examiner that the oxide, hydroxide or carbonate of silica, aluminum or zirconium meets applicants acid-stable particles absent evidence to the contrary. As for the property of the particles maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise.

6. Claims 1, 10-17, 26 and 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolan (US Patent No. 5,449,415).

Dolan teaches, in the abstract, examples and the claims, a chromium free conversion coating composition comprising a component of anions such as fluorotitanate or fluozirconate, a component of cations of elements, sufficient free acid so that the pH is in the range of from 0.5 to 5.0, a component of phosphorus containing inorganic oxyanions and phosphonate anions, a component of polymers..

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The instant claims are met by the reference. It is the position of the examiner that the component of cations of elements meets applicants acid-stable particles absent evidence to the contrary. As for the property of the particles maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise.

7. Claims 1, 10-17, 26 and 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Reghi et al (US Patent No. 5,897,716).

Reghi et al teaches, in the abstract, examples and the claims, a chromate free conversion coating composition comprising a component of various fluoroacids, a component selected from the group consisting of water soluble organic carboxylic acids, a component selected from various oxide, hydroxides etc., a component of polymers, a pH adjusting component to keep the pH in the range of from 1.2-4.5 (see column 4, lines 40+), a component selected from inorganic acids that do not contain fluorine, and a foam reducing amount of an antifoam agent.

The instant claims are met by the reference. It is the position of the examiner that the component selected from various oxide, hydroxides etc meets applicants acid-stable particles absent evidence to the contrary. As for the property of the particles maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise.

8. Claims 1, 5, 10-17, 26 and 31-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson et al (US Patent No. 6,464,800).

The reference teaches, in the abstract, the examples and the claims, a visible colored conversion coating composition comprising a product of chemical interaction between a first component selected from fluoroacids and a second component selected from titanium, zirconium, hafnium, boron, aluminum, silicon, germanium, and tin and the oxides of these. The pH is in the range of from 0 to 4 (column 6, lines 9-18). According to column 7, lines 42+, it is preferred that the total mass of the conversion coating dried into place on the treated surface should be at least, with increasing preference in the order given, 10, 20, etc. milligrams/square meter

The instant claims are met by the reference. It is the position of the examiner that the second component meets applicants acid-stable particles absent evidence to the contrary. Further since the fluoroacid interacts with the second component it is believed that claim 5 is met. As for the property of the particles maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise. With respect to claims 36-40 these are believed to be met by the reference as the dye of the reference would not materially affect the basic and/or novel characteristics of the invention, absent evidence to the contrary.

9. Claims 1, 10-17, 26 and 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Dolan (US Patent No. 6,764,553).

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Dolan teaches, in the abstract, examples and the claims, an aqueous composition comprising various fluorometallates which may further comprise an oxide, hydroxide or carbonate. The pH of the composition ranges from 1 to 8 (see column 4, lines 23+)

The instant claims are met by the reference. It is the position of the examiner that the oxide, hydroxide or carbonate meets applicants acid-stable particles absent evidence to the contrary. As for the property of the particles maintaining a particular change in viscosity, this is believed to be inherent properties possessed by the particles of the reference absent evidence showing otherwise.

### ***Claim Objections***

10. Claims 6, 9, and 30 are objected to because of the following informalities:

In claim 6 the phrase “aluminum-modified particles” is inconsistent with claim 2 which recites “aluminum-modified silica particles”.

In claim 9 the phrase “nonaluminum-modified particles” is inconsistent with claim 3 which recites “nonaluminum-modified silica particles”.

In claim 30 the phrase “organic particles” is inconsistent with claim 27 which recites “organic polymeric particles”.

. Appropriate correction is required.

***Specification***

11. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claims 20, 27 and 37 lacks proper antecedent basis in the specification as the specification recites “aluminum-modified silica particles” and “nonaluminum-modified silica particles”.

***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-17 and 26-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15, 18, 41-43, 45, 46, 48, 49, 51 and 56-59 of copending Application No. 10/339,405. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the reduction to practice of the claims of the copending application would render obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The instant claims are of a narrower scope than those of the copending application and are therefore seen to be encompassed by them.

***Information Disclosure Statement***

14. The remaining references have been considered however they are not seen to teach and/or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
April 26, 2006